

REMARKS

The above amendments and following remarks are submitted under 37 C.F.R. 1.116 in response to the final official action of the Examiner mailed November 4, 2005. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are now deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

Claims 1, 6, 11, 12, and 16 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,721,903, issued to Anand et al (hereinafter referred to as "Anand"). This ground of rejection is respectfully traversed for failure of the rejection to show that all claimed elements are met by Anand as required by MPEP 2131.

The standards for a finding of anticipation during examination are specified in MPEP 2131, which provides in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection is respectfully traversed because "the identical

"invention" is not shown by Anand "in as complete detail as is contained in the claim[s]".

With regard to claim 1, for example, it requires "a publicly accessible digital communications network" to couple the claimed "user terminal" to the claimed "data base management system". This network is not found in Anand, either expressly or inherently as required by MPEP 2131. In making his rejection, the Examiner cites the coupling between elements 30 and 32 of Fig. 1, which says nothing of a network, much less anything of the claimed network. The Examiner also cites column 6, lines 5-11, which states:

Client and server computers 30 and 32 are preferably coupled asynchronously for report requests; all other requests are satisfied synchronously. Communication between client and server computers 30 and 32 is preferably through transmission protocol/Internet protocol (TCP/IP), although other transmission protocols are also envisioned by the present invention. (Emphasis added)

This citation does not say that client and server computers 30 and 32 are coupled via the Internet as implied by the Examiner. It simply says that TCP/IP protocol is preferably though not necessarily utilized. Far more important is the statement all other requests are satisfied synchronously, which specifically precludes the claimed "publicly accessible digital communications network". As explained at great length by Applicant in his specification, a "publicly accessible digital communications network", in general and the Internet in particular, such

synchronous communication would expose the entire network to "hangups" by a given user. Therefore, Anand cannot possibly have the claimed network.

Having previously provided this argument to the Examiner, he has responded in the pending action stating:

Anand et al. discloses that the server and client are connected via TCP/IP protocol (col. 6, lines 7-11); that the reports are formatted in HTML (col. 4, lines 45-50); and that the servers containing the data warehouses can be distributed geographically (col. 3, lines 59-62).

Thus, the Examiner explicitly admits that Anand does not expressly disclose the claimed "publicly accessible digital communications network". Instead, the Examiner appears to rely upon inherency (the only other possibility under MPEP 2131) by reciting use of TCP/IP protocol, the HTML formatted data, and geographical distribution.

However, the use of TCP/IP protocol, HTML formatted data, and geographical distribution do not establish inherency under MPEP 2112, because these factors do not establish that Anand must of necessity employ the claimed "publicly accessible digital communications network" as required by MPEP 2112. In fact, the art is replete with examples of private networks which utilize TCP/IP protocol, HTML formatted data, and geographical dispersion. Therefore, the Examiner cannot prove inherency under MPEP 2112, as a matter of law, and has admitted that Anand does not disclose the claimed element expressly.

Claim 1 further requires "automatic" generation of the report delivered in accordance with the log-on service request. Applicant has previously argued concerning the "automatic" nature of this generation of this report (i.e., not user initiated) as distinguished from Anand wherein the SmartReport is user specified/defined. Because the arguments of the Examiner and Applicant tended to focus primarily upon the delivery rather than the generation, Applicant has herewith amended claim 1 to required a "plurality of user terminals", wherein the same report is automatically delivered to this "plurality of user terminals" upon individual log-on service requests.

The delivery of the same report to various user terminals is readily distinguishable from the delivery of the SmartReport in Anand, because Anand requires the user to specify or define his/her own SmartReport. Column 14, lines 41-43, states:

Report generation begins when a user chooses a SmartReport and an appropriate set of parameters in client subsystem 12.

Thus, it should be clear to the reader that Anand does not and cannot send the same report to a plurality of users, because the SmartReport of Anand is user specified/defined. Furthermore, Anand expressly teaches that the SmartReport cannot be "automatically" generated by the claimed "administration module" and "software object" which generate the report without user input.

Though amended claim 1 is somewhat different in scope from

previously pending claim 2, the Examiner has already addressed the matter of "a plurality of user terminals" receiving the same "report" in his rejection of claim 2. He has alleged the combination of Anand with U.S. Patent No. 5,892,909, issued to Grasso et al (hereinafter referred to as "Grasso") to show "wherein reports can be distributed to multiple user terminals". Yet, this alleged combination flies in the face of the clear teaching of Anand, which is limited to a user specified and defined SmartReport which is held in that user's dedicated storage area of return area manager 70 for delivery to that user. The purpose of Anand is summarized in the Abstract which begins:

A system and method for generating a report for a user which allows the user to make decisions without requiring the user to understand or interpret data itself.
(Emphasis added)

It makes no sense in the system of Anand to deliver a SmartReport to anyone other than the user who has defined and specified it.

The rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed.

These distinctions are even more apparent in considering claim 6. Element b of claim 6 directly claims the "publicly accessible digital communications network". As explained above, this element is not found in Anand, even though Anand suggests the use of TCP/IP as the preferred protocol.

Even more apparently absent from claim 6 is the limitation

which "delivers said report via said publicly accessible digital communications network in response to receipt of said log-on service request and not in response to a request for said report from said user terminal". As explained above, Anand specifically states that the data is transferred when "client subsystem 12 issues a request". Clearly, Anand does not meet the limitations of claim 6. Claim 6 has been further amended to require delivery of the same report to a plurality of user terminals. Therefore, the rejection of amended claim 6, and all claims depending therefrom, is respectfully traversed.

Claim 11 is an independent method claim having five basic steps. Anand cannot meet step five which requires "transmitting said display page from said data base management system to said user terminal in response to receipt of said log-on service request." Claim 11 has been further amended to require delivery of the same report to a plurality of user terminals. As explained above, Anand transfers data only in response to a user request for the transfer. The rejection of amended claim 11, and all claims depending therefrom, is respectfully traversed.

Claim 16, as amended, is an independent apparatus claim having five means-plus-function limitations. Anand cannot meet the fifth limitation which requires "delivering means responsively coupled to said generating means for delivering said report in response to receipt of said log-on service request". Claim 16 has been further

amended to require delivery of the same report to a plurality of user terminals. The rejection of amended claim 16, and all claims depending therefrom, is respectfully traversed.

Claim 12 depends from claim 11 and is further limiting of the software architecture of the user terminal. Anand cannot meet the limitations of claim 11 from which claim 12 depends. Therefore, Anand cannot meet the further limitations of claim 12. The rejection of claim 12 is respectfully traversed.

Claims 21-25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Anand in view of Grasso. This ground of rejection is respectfully traversed for failure of the Examiner to present as *prima facie* case of obviousness as required by MPEP 2143.

In addition to many of the issues discussed above, the claimed claim 21 is an independent apparatus claim having four elements wherein the fourth limitation requires "a report generation facility located within said legacy data base management system which generates a report and transfers it to said plurality of user terminals via said publicly accessible digital data communication network". The Examiner admits that this limitation is not found in Anand, because Anand delivers the SmartReport to the single user who has defined and specified it. Furthermore, Anand does not "expressly or inherently" disclose the claimed "publicly accessible digital data communication network" for the reasons discussed

above.

Therefore, the Examiner alleges the combination with Grasso.

The Examiner cites column 16, lines 1-4, which states:

(d) Identify the Recipients

The user selects the desired recipients for the distribution from the system directory list (address book). This includes individuals, groups and/or roles.
(Emphasis added)

According to Grasso, the user selects the distribution. In accordance with Applicant's invention, the selection is by the "report generation facility". The alleged combination with Grasso does not provide the missing limitation.

The rejection of claim 21, and all claims depending therefrom, is respectfully traversed.

Claim 22 depends from claim 21 and is further limiting of the log-on process. The alleged combination cannot meet the limitations of claim 21 from which claim 22 depends. Therefore, Anand cannot meet the further limitations of claim 22. The rejection of claim 22 is respectfully traversed.

Claim 23 depends from claim 22 and is further limited by an administration module. The alleged combination cannot meet the limitations of claim 22 from which claim 23 depends. Therefore, Anand cannot meet the further limitations of claim 23. The rejection of claim 23 is respectfully traversed.

Claim 24 depends from claim 23 and is further limiting of the

log-on process. The alleged combination cannot meet the limitations of claim 23 from which claim 24 depends. Therefore, Anand cannot meet the further limitations of claim 24. The rejection of claim 24 is respectfully traversed.

Claim 25 depends from claim 24 and is further limiting of the publicly accessible digital communications network. The alleged combination cannot meet the limitations of claim 24 from which claim 25 depends. Therefore, Anand cannot meet the further limitations of claim 25. The rejection of claim 25 is respectfully traversed.

Claims 2-4, 7-10, 13-14, and 17-18 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Anand in view of Grasso. This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143.

Claims 2, 7, and 13 depend from claims 1, 6, and 12, respectively. Furthermore, claim 2 requires that each of the multiple user terminals has a different log-on service request giving each of the multiple user terminals access to different portions of the claimed data base. There is no showing of this feature within the alleged combination. The rejection of claims 2, 7 and 13 is respectfully traversed.

Claims 3, 9, 14, and 17 depend from claims 2, 8, 13, and 16, respectively, and further limit the claimed publicly accessible

digital communications network. As explained above, the alleged combination has no such network. Anand requires "synchronous" transfers and Grasso is limited to Intranet systems (see title, for example). Therefore, the alleged combination cannot have these further limitations to the claimed network. The rejection of claims 3, 9, 14, and 17 is respectfully traversed.

Claims 4, 8, and 18 depend from claims 3, 7, and 17, respectively, and are further limited by a "repository" or storing means for storing the automatically generated report. The alleged combination does not have this limitation. The rejection of claims 4, 8, and 18 is respectfully traversed.

Claim 10 depends from claim 9 and is further limiting of the software architecture of the user terminal. The alleged combination cannot meet the limitations of claim 9 from which claim 10 depends. Therefore, Anand cannot meet the further limitations of claim 10. The rejection of claim 10 is respectfully traversed.

Claims 5, 15, and 19-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Anand in view of Grasso and further in view of "Unisys CSG MarketPlace-The Mapper System" (hereinafter referred to as "Unisys"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness. The references of the alleged combination are clearly incompatible. The rejection of claims 5, 15, and 18-20 is respectfully traversed.

Claim 20 depends from claim 19 and is further limiting of the software architecture of the user terminal. The alleged combination cannot meet the limitations of claim 19 from which claim 20 depends. Therefore, Anand cannot meet the further limitations of claim 20. The rejection of claim 20 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicant respectfully requests entry of this amendment and allowance of claims 1-25, being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

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